



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/594,794	06/16/2000	Yoshihito Mizuta	2000 0757A	9888

7590

07/10/2003

Wenderoth Lind & Ponack LLP
Suite 800
2033 K Street NW
Washington, DC 20006

EXAMINER

JOLLEY, KIRSTEN

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 07/10/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/594,794

Applicant(s)

MIZUTA, YOSHIHITO

Examiner

Kirsten Crockford Jolley

Art Unit

1762

--Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 June 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached Action.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 23-28,30-33,35-38,40 and 42.

Claim(s) withdrawn from consideration: 29,34,39,41,43 and 44.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

DETAILED ACTION

1. The proposed amendments will not be entered because they raise new issues that would require further consideration and/or search, and because they do not place the application in better form for appeal by materially reducing or simplifying the issues for appeal. Specifically, the changing of “thickness direction” to “loop shaped direction” as well as the addition of the phrase “such that a plane of the surface of the transfer liquid at a transfer initiating site extends through the loop shaped workpiece” in lines 5-7 are issues that would require further consideration and/or search.
2. Applicant argues that the rejections of the claims under 35 USC 112, 2nd paragraph as being indefinite is inappropriate because the scope of the claim is clearly understood by the Examiner, and therefore the finality of the Office action should be withdrawn in addition to the rejections. The Examiner notes that while the terms “thickness direction” and “longitudinal direction” were properly understood, it remains the Examiner’s position that there is still confusion and indefiniteness in the definition of the “cross section” in claim 23, as currently written. Since the cross section is taken “in a thickness direction” and also is “defined along a plane of the surface of the transfer liquid at a transfer initiating site”, then the transfer initiating site would necessarily exist at the point where a loop-shaped substrate is halfway immersed in the transfer liquid (since the plane of the surface of the transfer liquid is only coincident with the thickness direction when the loop-shaped substrate is half-immersed). With respect to this scenario, Applicant argues that the cross section defined at the transfer initiating site is not required to be the same cross section as that at which the transfer film substantially concurrently

Art Unit: 1762

contacts a circumference of the loop shaped workpiece. The Examiner notes that the term “cross section” is conventionally known in the art to be a cut of the object that is representative of the remainder of the length of the object; Merriam-Webster’s Collegiate Dictionary, 10th edition defines “cross section” as a composite representation typifying the constituents of a thing in their relations. Therefore, it is the Examiner’s position that one having ordinary skill in the art would have understood the “cross section” to be taken in a thickness direction which is perpendicular to the tangent because such a cut would typify the thickness and shape along the entire loop-shaped workpiece, as opposed to the cross section being located at a different plane within the workpiece. Further, a cross section that does not contact a circumference of the loop shaped workpiece would not be in a thickness direction; the thickness direction is defined as being perpendicular to the longitudinal direction in claim 23 (which would be a tangent to the circle as discussed in the prior Office action). For the above reasons, the Examiner maintains that claim 23 is vague and indefinite and that the finality of the rejection is maintained. While Applicant has removed the term “cross section” from proposed claim 45, it is noted that this claim has not yet been considered.

With respect to the rejections over JP 61-005981 A and Watanabe et al., Applicant argues that the references do not result in substantially concurrently contacting the circumference of a cross section of the loop shaped workpiece with the transfer film in the thickness direction. The Examiner notes that since JP ‘981 illustrates immersing in a vertical position and rotating, that the reference meets the limitations of claim 23 as discussed above. With respect to the Watanabe et al. reference, while Watanabe et al. does not specifically teach immersing its steering wheel workpiece in the transfer liquid to a depth of half its diameter, it is the Examiner’s position that it

Art Unit: 1762

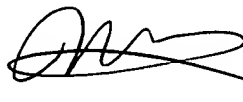
would have been obvious to one having ordinary skill in the art to have determined the optimum depth of immersion through routine experimentation, depending upon the amount of activator or adhesive used, and therefore the amount of liquid pressure needed to adhere the transfer pattern, through routine experimentation in the absence of a showing of criticality.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten Crockford Jolley whose telephone number is 703-306-5461. The examiner can normally be reached on Monday to Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on 703-308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1193.

kcj
July 8, 2003


MICHAEL BARR
PRIMARY EXAMINER